

REMARKS/ARGUMENTS

The Examiner in the communication filed January 29, 2009, required the election of a single species. Accordingly, Applicants elect the species:

2-(2,6-diarylphenyl)-9,10 diarylanthracene; or

2-(2,6-bisarylphenyl)-9,10-bisarylanthracene.

Applicants request that should the elected species be found allowable, the Examiner expand the search to include the non-elected species.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double patenting ground of rejection, 35 U.S.C. § 121, In re Joyce (Comr. Pat. 1957) 115 USPQ 412.

The Examiner alleges that the species recited in the specification are patentably distinct. However, the burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinction (M.P.E.P. § 803). Rather, the Office merely stated conclusions.

Accordingly, the Office has failed to meet the burden necessary to sustain the election requirement, and the Office has not shown that a burden exists in searching all of the species.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of the entire application would not constitute a serious burden on the Office.

In chemical cases a specified group of material which do not necessarily belong to an otherwise class can be claimed together. Separate substances which could not be defined by generic language but which nevertheless have a community of chemical or physical


characteristics should be examined together if they have at least one property in common which is mainly responsible for the claimed relationship. The same utility in a generic sense suffices.

Applicants make no statement regarding the patentable distinction of the species, but note that for the restriction/election to be proper there must be patentable differences between the species as claimed (M.P.E.P. § 808.01(a)).

Applicants' election is for examination only.

Respectfully submitted,

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